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EXAMINER

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1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

Applicant's arguments filed January 29, 2009 have been fully considered but they are not persuasive.

In the previous advisory action of January 12, 2009, the Office maintained the rejections of record and required a direct comparison with the closest prior art with the comparisons being commensurate in scope with the entire claim and that the experimental results be presented in a Rule 1.132 affidavit. Applicants argue that a direct comparison has been made, that the comparisons are commensurate in scope, and that these results do not need to be submitted in a Rule 1.132 affidavit. The Office maintains its position as set out in the advisory action of January 12, 2009 for the reasons as set forth in that action and find the present arguments unpersuasive. To reiterate the position of the Office, the previous remarks have been included below.

In order to show unexpected results, a comparison must be made with the closest prior art, the comparison should be a direct comparison, i.e., only changing on variable, and the comparisons must be commensurate in scope with the claimed invention, i.e., the results should be shown over the entire claimed range for all ingredients of the composition. The results shown as examples in the specification and brought to light in the arguments submitted on July 17, 2008, December 30, 2008, and January 29, 2008 do not meet the above criteria and therefore, do not show unexpected results.

First, a direct comparison was not made between the prior art and the claimed invention. The closest comparisons are Formulation F19 in Table 9, page 28 of the reference and the formulations of Example 1 shown in Table 4 of the instant specification. However, different tackifying resins are used (R-1090 v. R-7100) and a change in tackifying resins can affect the viscosity of the composition. Also, the viscosity measurement shown in the prior art reference was measured at 177° C and none of the results in the instant specification give the viscosity measurement at this temperature. Moreover, the alleged unexpected results need to be provided in a Rule 132 affidavit, not simply argued in the remarks section of a response to an Office Action.

Second, the examples shown are not commensurate in scope with the claimed invention. Unexpected results need to be shown over the entire claimed range of the tackifying resin, the

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plasticizer and the auxiliary and the same tackifying resin, plasticizer and auxiliary should be used to show the entire claimed range. Applicants argue in the remarks dated December 30, 2008 that they have shown unexpected results over the entire claimed range of the tackifying resin. However, the results show use of 250 parts by weight of R-1090 and then in a second example 272 parts by weight of R-7100. These are different resins and therefore do not show the entire claimed range using the same resin.

In conclusion, for unexpected results to be shown, they must be presented in a Rule 132 affidavit, be fully commensurate in scope with the claimed invention, and be a direct comparison with the closest prior art. Furthermore, in showing the criticality of the claimed range, it should be shown that the invention would not produce a hot melt adhesive when the molecular weight of the polymer is outside of the claimed range.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 270-3303. The examiner can normally be reached on Monday through Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/A. C. S./
Examiner, Art Unit 1796